

REMARKS/ARGUMENTS

Amendments

Before this Amendment, claims 1-41 and 43-45 were present for examination. Claims 1, 15, 29, 44, and 45 are amended. Therefore, claims 1-41 and 43-45 are present for examination, and claims 1, 15, and 29 are the independent claims. No new matter is added by these amendments. Applicants respectfully request reconsideration of this application as amended.

The Final Office Action dated February 14, 2006 ("Office Action") rejected claims 1-41 and 43-45 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of Patent No. WO/01/19005 A1 ("WO Rabenko") in view of the cited portions of Bowen et al., U.S. Patent No. 6,580,710 ("Bowen"). The Examiner, however, states that cited portions of U.S. Patent 6,819,682 to Rabenko et al. ("Rabenko") are identical to the reference, and the Rabenko column and line number are used for ease of reference. Applicants will also refer to Rabenko in this Amendment.

35 U.S.C. §103(a) Rabenko, Bowen

The Final Office Action rejected claims 1-41 and 43-45 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of Rabenko in view of the cited portions of Bowen. To establish a *prima facie* case of obviousness, the prior art references must "teach or suggest all the claim limitations." MPEP § 2143. The Applicant believes significant limitations from the amended independent claims are neither taught nor suggested in the references.

More specifically, none of the references cited above can be relied upon, either alone or in combination, to teach or suggest a NID configured to convert a set of digitally formatted video information into two different digital video formats for distribution to separate internal interfaces, as recited in independent claim 1. Similar limitations are found in independent claims 15 and 29, as amended. Support for the amendment can be found in the Specification (Original Application, p. 46, l. 15 - p. 47, l. 15).

Moreover, there is no suggestion in the references to modify the teachings of Rabenko to include Bowen. Rabenko is directed at the synchronization of timing information in a cable modem network; while Bowen is directed at intra-premises voice and data distribution using in place POTS telephone lines. The following excerpt is believed apt in the present case.

“In the instant application, the examiner has done little more than cite references to show that one or more elements or subcombinations thereof, when each is viewed in a vacuum, is known. The claimed invention, however, is clearly directed to a combination of elements. That is to say, appellant ... has presented claims to a new combination of elements.” Ex parte Clapp, 227 USPQ 972, 973 (B.P.A.I. 1985).

The basic test for establishing obviousness requires that to "establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings The teaching or suggestion to make the claimed combination . . . must . . . be found in the prior art, not in the applicant's disclosure." MPEP § 2143.

The Office instead relies upon the contention that the "arrangement provides broadband services to the customer without the expense and inconvenience of installing new network wiring (Office Action, p. 3, ll. 8-9). But this does not constitute proper motivation - it addresses the benefits of the combination, and not a motivation to combine the teachings of the references. Unless the art itself "suggests the desirability of the combination," benefits alone are clearly not enough. MPEP 2143.1.

CONCLUSION

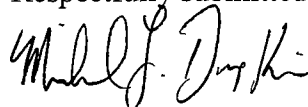
In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

Appl. No. 10/715,878
Amdt. dated April 6, 2006
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 2646

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Michael L. Drapkin
Reg. No. 55,127

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
MLD:klb
60711259 v1